



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,498	01/27/2004	Nicholas J. Elsey	41698.1112	3495

7590 11/04/2005
Alex L. Yip
Kaye Scholer LLP
425 Park Avenue
New York, NY 10022

EXAMINER

HOOSAIN, ALLAN

ART UNIT PAPER NUMBER

2645

DATE MAILED: 11/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,498

Applicant(s)

ELSEY ET AL.

Examiner

Allan Hoosain

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 39-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 39-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

FINAL DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 39-44,46-53,56,58 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Maloney et al.** (US 5,555,299).

As to Claims 39,56, with respect to Figures 4-5, **Maloney** teaches a method for use in a directory assistance system, comprising:

receiving a call from a caller, the call including a current request for an apparel purchase (a suggestion of a provider of a product or service) desired by the caller (Col. 9, lines 1-6);

retrieving, from storage, data concerning the manner in which one or more prior requests by the caller were handled (Col. 9, lines 15-24);

utilizing at least the retrieved data to identify a product or service provider in response to the current request (Col. 9, lines 24-35);

searching a database for connection information concerning the identified product or service provider (Col. 9, lines 35-45);

facilitating a communication between the caller and the identified product or service provider based on the connection information (Col. 9, lines 35-45);

Art Unit: 2645

storing, in the storage, data concerning the manner in which the current request is handled (Col. 9, lines 45-54); and

after the caller communicates with the identified product or service provider, allowing the caller to transfer (return to the directory assistance system) without terminating the call (Col. 9, lines 45-54).

As to Claim 40, **Maloney** teaches the method of claim 39, wherein the one or more prior requests were received in the same call as the current request (Col. 9, lines 30-45 and Col. 10, lines 1-15).

As to Claim 41, **Maloney** teaches the method of claim 39, wherein the connection information including a telephone number (Col. 9, lines 15-18).

As to Claim 42, **Maloney** teaches the method of claim 41, wherein the communication includes a telephone connection (Figure 1).

As to claim 43, **Maloney** teaches the method of claim 39, wherein the caller is returned to the directory assistance system automatically after a disconnection by the identified product or service provider of the communication between the caller and the identified product or service provider (Col. 9, lines 45-52).

Art Unit: 2645

As to Claim 44, **Maloney** teaches the method of claim 43, wherein the caller is returned to the directory assistance system after seconds (a predetermined period) from the disconnection (Col. 9, lines 65-67).

As to Claims 46,58, with respect to Figures 4-5, **Maloney** teaches a method for use in a directory assistance system, comprising:

- receiving, from a caller, a current request for a food purchase (suggestion of a provider of a product or service) desired by the caller (Col. 9, lines 35-45);

- retrieving, from the directory assistance system, data concerning one or more prior requests by the caller (Col. 9, lines 20-25);

- identifying, based at least on the retrieved data, a product or service provider in response to the current request (Col. 9, lines 40-45);

- assigning software (an agent in the directory assistance system), the software (agent) communicating with the food call center (product or service provider) on behalf of the caller to satisfy the current request (Col. 9, lines 45-54); and

- storing, in the directory assistance system, data concerning the current request in association with the caller (Col. 9, lines 23-24).

As to Claim 47, **Maloney** teaches the method of claim 46, further comprising receiving information concerning the caller, and generating a ticket containing details of the desired product or service, wherein select fields of the ticket are populated with the received information (Col. 9, lines 15-25).

Art Unit: 2645

As to Claim 48, **Maloney** teaches the method of claim 47, wherein the received information comprises the caller's telephone number (Col. 9, lines 15-17).

As to Claim 49, **Maloney** teaches the method of claim 47, wherein the received information comprises the caller's home address (Col. 9, lines 25-26).

As to Claim 50, **Maloney** teaches the method of claim 47, wherein the received information comprises the caller's present location (Col. 15-19).

As to Claim 51, **Maloney** teaches the method of claim 46, wherein the retrieved data comprises one or more caller preferences (Col. 9, lines 1-5).

As to Claim 52, **Maloney** teaches the method of claim 51, wherein the one or more caller preferences include preferences for selected company divisions (geographic regions) (Col. 9, lines 1-5).

As to Claim 53, **Maloney** teaches the method of claim 47, further comprising entering the food division (name of the product or service provider) at which a reservation is desired on the ticket, accessing a database to retrieve other information regarding the product or service provider, and automatically populating selected fields of the ticket with said other information (Col. 9, lines 45-51, 55-65).

Art Unit: 2645

3. Claims 39,46 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Anderson et al.** (US 5,757,904).

As to Claim 39, with respect to Figures 2-5, **Anderson** teaches a method for use in a call center (directory assistance system), comprising:

receiving a call from a caller, the call including a current request for reservation changes (a suggestion of a provider of a product or service) desired by the caller (Col. 4, lines 63-67);

retrieving, from storage, data concerning the manner in which one or more prior requests by the caller were handled (Col. 5, lines 4-7);

utilizing at least the retrieved data to identify a product or service provider in response to the current request (Col. 4, lines 63-67);

searching a database for connection information concerning the identified product or service provider (Col. 5, lines 1-15);

facilitating a communication between the caller and the identified product or service provider based on the connection information (Col. 5, lines 14-15,25-30);

storing, in the storage, data concerning the manner in which the current request is handled (Col. 5, lines 40-41); and

after the caller communicates with the identified product or service provider, allowing the caller to transfer (return to the directory assistance system) without terminating the call (Col. 5, lines 30-38).

Art Unit: 2645

As to Claim 46, with respect to Figures 1-5, **Anderson** teaches a method for use in a directory assistance system, comprising:

receiving, from a caller, a current request for call direction (suggestion of a provider of a product or service) desired by the caller (Col. 8, lines 1-5);

retrieving, from the directory assistance system, data concerning one or more prior requests by the caller (Col. 8, lines 52-58);

identifying, based at least on the retrieved data, a product or service provider in response to the current request (Col. 8, lines 58-65);

assigning an agent in the directory assistance system, the agent communicating with the product or service provider on behalf of the caller to satisfy the current request (Col. 9, lines 1-7); and

storing, in the directory assistance system, data concerning the current request in association with the caller (Col. 9, lines 25-29).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any

Art Unit: 2645

evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 45,54 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Maloney** in view of **Marwell et al.** (US 6,404,884).

As to Claims 45,54, **Maloney** teaches the method of claim 39, wherein the identified product or service provider includes purchasing from catalogs;

Maloney does not teach the following limitation:

“a restaurant”

However, it is obvious that **Maloney** suggests the limitation. This is because **Maloney** teaches order and service placements using CSRs (Col. 1, lines 37-40). **Marwell** teaches CSR placement of restaurant services (Col. 18, line 66 through Col. 19, line 3). Having the cited analogous art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to restaurant reservations to **Maloney's** invention for additional service offerings as taught by **Marwell's** invention in order to maximum services and responsiveness to customers.

7. Claims 55,57,59 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Maloney**.

Art Unit: 2645

As to Claims 55,57,59, **Maloney** teaches a method for use in call center 50 (a directory assistance system), comprising:

receiving a call from a caller, the call including a current request for a suggestion of a CSR2 (a third party provider) of foods (a product or service) desired by the caller, wherein the CSR2 (third party) is not associated with the call center 50 (directory assistance system);

generating a record comprising the request (Col. 9, lines 25-45);

identifying a foods product division (geographical region) based on the record (Col. 9, lines 42-45);

transferring the record to call center 71 (a call center) associated with the foods product division (geographic region) (Col. 9, lines 55-67);

identifying CSR2 (a third party provider) of foods (a product or service) that is not associated with call center 50 (the directory assistance system) and is located in the geographical region, based on the record (Col. 9, lines 55-67);

searching a database for connection information concerning the identified third party product or service provider (Col. 9, lines 55-60);

facilitating a communication between the caller and the identified third party product or service provider based on the connection information (Col. 10, lines 1-25);

storing, in the storage, data concerning the manner in which the current request is handled (Col. 9, lines 20-25); and

after the caller communicates with the identified third party product or service provider, allowing the caller to transfer;

Maloney does not teach the following limitation:

Art Unit: 2645

“allowing the caller to return to the directory assistance system without terminating the call”

However, it is obvious that **Maloney** suggests the limitation. This is because **Maloney** teaches transferring a caller from one call center to another call center and determines after each transfer, whether further transfer needs to take place by asking the caller “Is there anything else I can help you with today?” (Figure 5, label 142). This teaching suggests that a caller, after being transferred from call center 50 to call center 71 can request transfer back to call center 50 to purchase further items. Therefore, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add return callers to call center 50 after being serviced at call center 71 so as to allow a caller to purchase the navy coat or purchase other apparel.

Response to Arguments

8. Applicant's arguments filed in the 8/19/05 Remarks have been fully considered but they are not persuasive because of the following:

Maloney rejections

Maloney teaches that the caller expressed an interest in buying merchandise from the November catalog and was helped by the CSR to select the color of the pea coat. The interest in buying is a suggestion because the CSR helped in the selection. **Maloney** also teaches that the record was for Ima Byer, a known customer, still at a certain address. The known customer teaches inherently prior requests because a customer is someone who buys. The address is the manner in which inherent prior requests were handled because purchases would have had to be

Art Unit: 2645

mailed to that address. With respect to Claim 46, the software determines to which CSR the transferred call should be connected. This determination is assigning as claimed (Col. 9, lines 55-61). In addition, Maloney teaches that the call is returned to the first call center (directory assistance system) before being transferred (call not terminated) (Col. 10, lines 51-66).

Anderson rejections:

With respect to Claim 39, Anderson teaches that the caller Mr. Allen expressed a need to make reservation changes. This need is a suggestion because the agent helped Mr. Allen to change his reservations with suggested flights (see Col. 5, line 65 through Col. 6, line 7). Mr. Allen first speaks with Agent Eng before being transferred to Agent Doe. The call is returned to the ACD (directory assistance system) and not terminated (Col. 5, lines 30-36).

With respect to Claim 46, **Anderson** teaches that the receptionist (service provider) communicates with **Shiela** or other agents by obtaining her status and Shiela obtains a visual indication (Col. 9, lines 1-10). The skill is based on the product discussed with Shiela in the prior call (see also Col. 8, lines 52-58).

35 USC 103 Rejections

Examiner respectfully believes that the rejections were proper based on Examiner responses above.

Invitation

Examiner respectfully invites Applicants to contact Examiner to discuss possible amendments for overcoming the prior art of record.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Morganstein et al. (US 5,020,095) teach connecting calling parties to third parties based on callers selections.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any response to this final action should be mailed to:

Box AF
Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

Art Unit: 2645

(571) 273-8300, (for formal communications; please mark "EXPEDITED PROCEDURE")

Or:

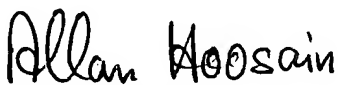
(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to Carlyle, Alexandria, VA 22313 (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (571) 272-7543. The examiner can normally be reached on Monday to Friday from 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (571) 272-7547.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.


Allan Hoosain
Primary Examiner
10/19/05